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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,864	07/16/2001	Tatsuya Nishio	1114-168	5462
23117	7590	09/07/2005	EXAMINER	
NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			TRAN, NGHI V	
			ART UNIT	PAPER NUMBER
			2151	

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/904,864

Applicant(s)

NISHIO ET AL.

Examiner

Nghi V. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 03/11/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 3-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada, Japan Patent Application Publication No. 10-190995, in view of Hayashi, Japan Patent Application Publication No. 05-347677.

3. With respect to claims 1, 5, 7, Okada teaches a communication apparatus connected to a network, capable of transmitting and receiving FAX data [see abstract], comprising:

- memory means [2] for storing received data [paragraph 0021]; and
- control means for controlling so that, when the memory means reaches a memory overflow condition during data reception from a transmission side, the communication apparatus is disconnected from a communication path to the transmission side and data received and stored in the memory means is processed, and when the memory means recovers from the memory overflow condition and a free area is formed in the memory means, the transmission

side is automatically called for the communication apparatus to restart the data reception [paragraphs 0005-0033].

However, Okada is silent on a communication apparatus capable of transmitting and received electronic mail.

In a communication apparatus, Hayashi discloses a communication apparatus capable of transmitting and received electronic mail [see abstract].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Okada in view of Hayashi by transmitting and received electronic mail because this feature enables to transfer of FAX data in the electronic mail [Hayashi, see abstract]. It is for this reason that one of ordinary skill in the art at the time of the invention would have been motivated to modify Okada in view of Hayashi in order to transmission and reception of an electronic mail [Hayashi, paragraph 0005].

4. With respect to claim 3, Okada further teaches when the memory means reaches the memory overflow condition and the communication apparatus is disconnected from the communication path, a delete signal for erasing the relevant data stored in the transmission side is not sent [see abstract and paragraphs 0005-0006].

5. With respect to claim 4, Okada further teaches when data is not provided as a result of a request of data, recalling is repeatedly performed with predetermined timing [paragraph 0007-0014 and 0033].

6. With respect to claim 6, Okada further teaches the control means controls so that, when the data reception is interrupted, and the data stored in the memory means by the data reception is printed on the recording sheet, a data portion printed on a recording sheet by the printing means is stored in the memory, and when data reception is restarted, the data stored in the memory means by the data reception is compared with data already stored in the memory means and data except for the data portion already printed on the recording sheet on the recording sheet is printed on the a recording sheet [paragraphs 0005-0033].

7. With respect to claims 8 and 10, Okada further teaches the control means controls so that when the memory overflow condition of the memory means is caused during the data reception, the data reception is interrupted, and when the memory means recovers from the memory overflow condition, data reception is restarted [paragraphs 0005-0014].

8. With respect to claim 9, Okada further teaches the control means controls so that when the memory overflow condition of the memory means is caused during the data reception, the data reception is interrupted, and when the memory means recovers from the memory overflow condition, data reception is restarted [see abstract].

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9. With respect to claims 11-13, Okada further teaches the communication apparatus embodied as a facsimile machine [see abstract].

10. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over both Okada and Hayashi, and further in view of Suzuki, U.S. Patent No. 6,549,947.

11. With respect to claim 2, Okada is silent on notifying means for, when the memory means reaches the memory overflow condition, notifying a user of the memory overflow condition by a voice message or a display, so as to make recovery of the memory means from the memory overflow condition.

In a communication apparatus, Suzuki discloses notifying means (9 i.e. error or warning display on the display (11)) for, when the memory means reaches the memory overflow condition, notifying a user (col.2, Ins.6-8) of the memory overflow condition by a voice message or a display, so as to make recovery of the memory means from the memory overflow condition (col.1, ln.46 - col.2, ln.27).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Takaya in view of Suzuki by adding notifying means because this feature enables the users to view errors (i.e. continue, suspend, or resume transmission of subsequent data). It is for this reason that one of ordinary skill in the art at the time of the invention would have been motivated to modify Takaya in view of Suzuki in order to inform the user of the status of error.

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12. Claims 14-20, 22-26, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki, U.S. Patent No. 6,549,947, in view of Okada, Japan Patent Application Publication No. 10-190995.

13. With respect to claims 14 and 23, Suzuki teaches a communication apparatus [3 i.e. dumb printer] that selectively retrieves data from a server [1 i.e. host computer] [see abstract and fig.1], the communication apparatus comprising:

- a communication circuit [fig.1 i.e. commands (print data and data request) and replies (status and error data)];
- a memory that stores the data retrieved from the server [23 i.e. RAM];
- a controller for controlling the communication circuit to attempt to connect to the server and, if a connection is made, for retrieving the data [25 i.e. DMA controller],

However, Suzuki is silent on wherein, when the controller detects a memory overflow condition during the retrieving of the data, the connection to the server is broken such that the data is retained by the server and, when the controller detects that the memory overflow condition is resolved, the controller automatically attempts to re-connect to the server and, if a connection is made, retrieves the data.

In a communication apparatus, Okada discloses wherein, when the controller detects a memory overflow condition during the retrieving of the data, the connection to the server is broken such that the data is retained by the server and, when the controller detects that the memory overflow condition is resolved, the controller automatically

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attempts to re-connect to the server and, if a connection is made, retrieves the data [paragraphs 0005-0033].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Suzuki in view of Okada by broken the connection to the server when the controller detects a memory overflow and automatically attempts to re-connect to the server if a connection is made because this feature stores the number of pages having been sent thus far without re-transmission [Okada, see abstract]. It is for this reason that one of ordinary skill in the art at the time of the invention would have been motivated in order to prevent the repetition of useless communication such that reception is disabled because a capacity of a receiver facsimile equipment overflows in the middle of reception [Okada, see abstract].

14. With respect to claim 15, Okada further teaches the controller controls the communication circuit to attempt to connect to the server. However, Okada is silent on attempting to connect to the server in response to user inputs to the communication apparatus. In addition, manually connected to the server [see the prior art made of record below, Lin et al., U.S. Patent No. 5,881,064 i.e. "the user inputs the address data (i.e., 222444) of the information server and then dials/accesses the number of the desired report or information (i.e., 0023)"] is well know in the art.

15. With respect to claim 16, Suzuki is silent on the controller controls the communication circuit to attempt to connect to the server automatically.

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In a communication apparatus, Okada discloses the controller controls the communication circuit to attempt to connect to the server automatically [paragraphs 0007-0014 and 0033].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Suzuki in view of Okada by automatically attempt to connect to the server because this feature performs automatically retransmission of message from the page which was not able to be sent [Okada, paragraph 0014]. It is for this reason that one of ordinary skill in the art at the time of the invention would have been motivated Suzuki in view of Okada in order to retransmit automatically.

16. With respect to claim 17, Suzuki is silent on the communication apparatus sends a delete signal to server for deleting the data after the data is retrieved.

In a communication apparatus, Okada discloses the communication apparatus sends a delete signal to server for deleting the data after the data is retrieved [paragraph 0014 and 0021-0033].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Suzuki in view of Okada by sending a delete signal to server for deleting the data after the data is retrieved because this feature increases more memory space [Okada, paragraphs 0011 and 0014]. It is for this reason that one of ordinary skill in the art at the time of the invention would have been

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motivated Suzuki in view of Okada in order to prevent memory overflow [Okada, see abstract].

17. With respect to claim 18, Suzuki is silent on the controller automatically re-attempts to connect to the server one or more times if a connection is not made.

In a communication apparatus, Okada discloses the controller automatically re-attempts to connect to the server one or more times if a connection is not made [paragraphs 0007-0014 and 0033].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Suzuki in view of Okada by automatically attempt to connect to the server because this feature performs automatically retransmission of message from the page which was not able to be sent [Okada, paragraph 0014]. It is for this reason that one of ordinary skill in the art at the time of the invention would have been motivated Suzuki in view of Okada in order to retransmit automatically.

18. With respect to claims 19 and 25, Okada further discloses embodied as a facsimile machine [see abstract].

19. With respect to claims 20 and 26, Okada further teaches embodied as a multimedia communication apparatus [see abstract].

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20. With respect to claims 22 and 29, Okada further teaches the controller detects the memory overflow condition based at least in part on whether or not a printer can print the retrieved data [paragraphs 0015-0033].

21. With respect to claim 24, Suzuki further teaches the data retrieved from the server and printed prior to the breaking of the connection is stored in the memory [col.1, Ins.49-55] and marked to permit the controller to determine which pages have been previously printed [col.3, Ins.54-57 i.e. "print only pages, not previously printed" is inherent as "retains the print data pertaining to a page that has already been transmitted to the printer"].

22. Claims 21 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over both Suzuki and Okada, and further in view of Hayashi, Japan Patent Application Publication No. 05-347677.

23. With respect to claims 21 and 27, both Suzuki and Okada are silent on the retrieved data comprises electronic mail.

In a communication apparatus, Hayashi discloses a communication apparatus capable of transmitting and received electronic mail [see abstract].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify both Suzuki and Okada in view of Hayashi by transmitting and received electronic mail because this feature enables to transfer of

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FAX data in the electronic mail [Hayashi, see abstract]. It is for this reason that one of ordinary skill in the art at the time of the invention would have been motivated to modify both Suzuki and Okada in view of Hayashi in order to transmission and reception of an electronic mail [Hayashi, paragraph 0005].

24. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over both Suzuki and Okada, and further in view of Kadota et al., U.S. Patent Application Publication No. 2001/0043723 (hereinafter Kadota).

25. With respect to claim 28, both Okada and Suzuki are silent on the retrieved data which is stored in the memory and not printed prior to the breaking of the connection is erased.

In a communication apparatus, Kadota discloses the retrieved data which is stored in the memory and not printed prior to the breaking of the connection is erased [Kadota, paragraph 0115, page 7 i.e. "the reception data is cleared to ease incomplete data"].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify both Suzuki and Okada, and further in view of Kadota by erasing the data stored in the memory means which is not printed on a recording sheet before the breaking of the connection because this feature avoids duplication or incomplete data. It is for this reason that one of ordinary skill in the art at

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the time of the invention would have been motivated to modify both Suzuki and Okada, and further in view of further in view of Kadota in order to reduce end-to-end error.

Response to Arguments

26. Applicant's arguments with respect to claims 1-29 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

27. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on March 11, 2005 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi V Tran whose telephone number is (571) 272-4067. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571) 272-3939. The fax phone number for the organization where this application or proceeding is assigned is 571.273.8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nghi V Tran
Patent Examiner
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NT


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